

## REMARKS

Claims 20, 70 and 76 are amended. The amendments to the claims are supported by the application as filed and do not present new matter. (See, e.g., Para. 109 (downstream messages are those sent by a user); Para. 114 (up stream messages are sent from a remote device such as a detector)). Claims 1-29 and 51-79 are currently pending in the application. Reconsideration of the application, as amended, is respectfully requested.

### **I. The Inherency Of All Of The Limitations Of Independent Claims 1, 20, 51, and 70 Has Not Been Established**

As an initial matter, Applicants request withdraw of the rejection of independent claims 1, 20, 51 and 70 and respective dependent claims 2, 4-6, 10, 21, 23, 24, 26, 29, 52, 54-56, 59, 60, 71, 73, 74, 76 under 35 U.S.C. § 102(e) since the assertions concerning inherent teachings of Hoffman do not have the required specificity and do not satisfy the initial burden of rejecting the claims under 35 U.S.C. § 102(e).

Applicants kindly acknowledge that the Office action has not identified specific sections of Hoffman that expressly disclose each and every limitation of independent claims 1, 20, 51 and 71 and various dependent claims. Instead, the rejection of independent claims 1, 20, 51 and 70 and various dependent claims is based on a general, blanket assertion that each and every limitation of these claims is inherently disclosed by in Hoffman.

Regarding the Office action's blanket assertion that Hoffman inherently discloses certain claim limitations, Applicants note that "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 (emphasis added), citing *In re Rijckaert*, 9 F.3d 1531, 1524 (Fed. Cir. 1993) (reversed rejection based on inherency assertion). Rather, "extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference..." MPEP § 2112 (emphasis added), citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* Further, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112, citing *Ex parte Levy*, 17 USPQ2d 1461, 1644 (Bd. Pat. App. & Inter. 1990).

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. However, such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. MPEP § 2131.01, citing *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

The Office action assertions that independent claims 1, 20, 51 and 70 are anticipated by Hoffman do not meet these requirements. Instead, the Office action provides only a general, blanket assertion that Hoffman inherently discloses each and every limitation of these claims. The Office action, however, has not provided any basis in fact to support this assertion. Moreover, the Office action has not provided any explanation as to why each and every limitation of independent claims 1, 20, 51 and 70 is necessarily present in Hoffman, and necessarily flows from the teachings of Hoffman. Moreover, the Office action has not presented any extrinsic evidence to support these blanket assertions. Therefore, the rejection of independent claims 1, 20, 51 and 70 and respective dependent claims 2, 4-6, 10, 21, 23, 24, 26, 29, 52, 54-56, 59, 60, 71, 73, 74, 76 under 35 U.S.C. § 102(e) should be withdrawn.

Further, Applicants request withdraw of the rejection of independent claims 1, 20, 51 and 70 and respective dependent claims 2, 4-6, 10, 21, 23, 24, 26, 29, 52, 54-56, 59, 60, 71, 73, 74, 76 under 35 U.S.C. § 102(e) since the rejection does not adequately set forth the basis for the rejection. The rejection does not have the specificity required to allow Applicants to adequately respond and has not satisfied the initial burden of properly rejecting the claims under 35 U.S.C. § 102(e). In particular, 35 U.S.C. § 132 states, "Whenever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection, . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application..." 37 C.F.R. § 104(c)(2) states "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Applicants respectfully submit that the

ordinary skill. MPEP § 2131.01, citing *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

The Office action assertions that independent claims 1, 20, 51 and 70 are anticipated by Hoffman do not meet these requirements. Instead, the Office action provides only a general, blanket assertion that Hoffman inherently discloses each and every limitation of these claims. The Office action, however, has not provided any basis in fact to support this assertion. Moreover, the Office action has not provided any explanation as to why each and every limitation of independent claims 1, 20, 51 and 70 is necessarily present in Hoffman, and necessarily flows from the teachings of Hoffman. Moreover, the Office action has not presented any extrinsic evidence to support these blanket assertions. Therefore, the rejection of independent claims 1, 20, 51 and 70 and respective dependent claims 2, 4-6, 10, 21, 23, 24, 26, 29, 52, 54-56, 59, 60, 71, 73, 74, 76 under 35 U.S.C. § 102(e) should be withdrawn.

Further, Applicants request withdraw of the rejection of independent claims 1, 20, 51 and 70 and respective dependent claims 2, 4-6, 10, 21, 23, 24, 26, 29, 52, 54-56, 59, 60, 71, 73, 74, 76 under 35 U.S.C. § 102(e) since the rejection does not adequately set forth the basis for the rejection. The rejection does not have the specificity required to allow Applicants to adequately respond and has not satisfied the initial burden of properly rejecting the claims under 35 U.S.C. § 102(e). In particular, 35 U.S.C. § 132 states, "Whenever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection, . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application..." 37 C.F.R. § 104(c)(2) states "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Applicants respectfully submit that the general blanket assertions regarding the inherent disclosure of Hoffman are deficient for the additional reason of failing to satisfy these requirements.

If the rejection of independent claims 1, 20, 51 and 70 and their respective dependent claims stands following this Amendment, Applicants respectfully request the Examiner to set forth reasons with the required degree of specificity explaining how each and every limitation of

general blanket assertions regarding the inherent disclosure of Hoffman are deficient for the additional reason of failing to satisfy these requirements.

If the rejection of independent claims 1, 20, 51 and 70 and their respective dependent claims stands following this Amendment, Applicants respectfully request the Examiner to set forth reasons with the required degree of specificity explaining how each and every limitation of every rejected claim is necessarily present in Hoffman in accordance with 35 U.S.C. § 102(e), § 132, 37 C.F.R. § 104(c)(2), MPEP §§ 2112 and 2131.01. Applicants, however, offer the following remarks to advance prosecution to the extent that the bases of the rejections can be ascertained.

Before addressing the particulars concerning the inherency assertions, Applicants believe that a short description of the subject application and Hoffman would be productive.

The subject application relates to monitoring items of a user, such as motor vehicle, and the status of various aspects of the vehicle. Related to this purpose, the subject application explains that the amount of information that can be transmitted within a short time and within constraints of a data protocol must be optimized. With a vehicle-based system, for example, a user may want to know when a break-in has occurred and other information regarding the break-in, such as whether the vehicle is in motion, the location and speed of the vehicle, etc. Known in-vehicle devices, however, may have a limited amount of time within which to transmit these data before the thief disables the apparatus. Moreover, data transmitted by known in-vehicle devices may have a limited number of bytes or digits within which all of the notification information must be encoded. Embodiments address these shortcomings by increasing the amount of data that can be transmitted using a fixed-length data packet, such as a 15 bit fixed-length data packet, by encoding multiple types of data in a single field of the fixed-length data packet. (Paras. 11 and 16).

Hoffman, on the other hand, relates to a personal security and tracking system that includes a portable signaling unit 20 and a remote alarm switch unit 40 or wristband, both of which are worn or carried by an individual being monitored. (Hoffman, Figure 1) The system also includes a central dispatch station 80. Distress signals and position coordinates are transmitted to the dispatch station. (Hoffman, Para. 49). The remote alarm switch unit 40 automatically generates a signal or alarm if the circuit is opened, e.g., when the unit 40 is removed from the individual. (Hoffman, Para. 74). Hoffman, however, does not disclose or

suggest specific details of the protocol that is used to transmit signals between the wristband and dispatch unit. Further, Hoffman does not disclose or suggest the issue concerning transmitting more status data over a fixed-length data packet, or why it would be necessary to encode second and third types of status data in a second data field (rather than in respective second and third data fields) of a fixed-length data packet.

## **II. Independent Claims 1 And 51 And Respective Dependent Claims Are Novel Over Hoffman**

Independent claims 1 and 51 and respective dependent claims 2, 4-6, 10, 12, 17-19, 52, 54-56, 59, 60 and 66-69 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication Number 2004/0014478 to Hoffman (“Hoffman”). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference MPEP § 2131 (emphasis added), citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306 (Fed. Cir. 2003). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicants respectfully traverse the rejection.

### **A. Hoffman Does Not Disclose Or Suggest Obtaining First, Second And Third Types Of Status Data As Recited In Independent Claims 1 and 51**

Applicants respectfully submit that Hoffman does not disclose or suggest “obtaining a first type of status data, a second type of status data, and a third type of status data” as recited in claim 1 and “means for obtaining a first type of status data, a second type of status data, and a third type of status data” as recited in claim 51. The Office action refers to paragraphs 40 and 73 of Hoffman to support the rejection.

Paragraph 40 of Hoffman describes a security system in which a central dispatch operator has control to initiate a request. The request described in Paragraph 40 is made by the central dispatch operator, not the user or person wearing the units 20 and 40. Paragraph 40 is silent as to obtaining a first, second and third types of status data.

Paragraph 73 of Hoffman describes a unit 40 having manual push-buttons 42a-c, which are marked with different symbols and/or colors to indicate increasing order of alarm priority. Thus, the asserted “status” data is only one type of data (alarm data), not three types of status data, as recited in claims 1 and 51. Further, based on the description provided in Hoffman, it

would appear that a user would press only one of the three buttons so that a signal with the proper priority indication is sent to the central dispatch operator. Thus, only one alarm signal would actually be transmitted from the unit 40 since pressing three buttons to generate three alarm signals would negate the very purpose of having different alarm push buttons to indicate different alarm priorities. (Hoffman, para. 73). This conclusion is consistent with paragraph 51 of Hoffman, which describes displaying to an operator the type of alarm.

Thus, Hoffman does not disclose or suggest “obtaining a first type of status data, a second type of status data, and a third type of status data” as recited in claims 1 and 51.

B. Hoffman Does Not Disclose or Suggest Encoding A First Type Of Data In A First Data Field Of Fixed Length Data Packet As Recited In Independent Claims 1 And 51 And Dependent Claims 21 and 71

Applicants also respectfully submit that Hoffman does not disclose or suggest “encoding the first type of status data in a first data field of a fixed-length data packet” as recited in claim 1 and “means for “encoding the first type of status data in a first data field of a fixed-length data packet” as recited in claim 51. Dependent claims 21 and 71 also include “fixed-length data packet” limitations. The Office action cites paragraph 74 of Hoffman to support the rejection.

Paragraph 74, however, does not disclose or suggest a fixed-length data packet, and does not disclose or suggest encoding the first type of data in a first data field of a fixed-length data packet. Rather, Hoffman describes components of a switch unit 40, which generates a signal if the circuit is determined to be opened (when the unit 40 is removed from a person). Hoffman is silent as to a fixed-length packet and encoding of status data in a field of a fixed-length packet.

Thus, paragraph 74 of Hoffman does not disclose or suggest “encoding the first type of status data in a first data field of a fixed-length data packet” as recited in claims 1, 21, 51 and 71.

C. Hoffman Does Not Disclose Or Suggest Encoding Second And Third Types Of Status Data In A Second Data Field Of Fixed Length Data Packet As Recited In Independent Claims 1 and 51

Applicants respectfully submit that Hoffman does not disclose or suggest “encoding the second type of status data and the third type of status data in a second data field of a fixed-length data packet” as recited in claim 1 and “means for encoding the second type of status data and the third type of status data in a second data field of a fixed-length data packet” as recited in claim 51.

The subject application explains that the amount of information that can be transmitted within a short time and within the constraints of the data protocol must be optimized. With a vehicle-based system, for example, a user may want to know when a break-in has occurred and other information regarding the break-in, such as whether the vehicle is being moved, the location and speed of the vehicle, etc. Embodiments address data capacity limitations of known devices using a fixed-length data packet by encoding multiple types of status data in a single data field of the fixed-length data packet.

The Office action cites paragraph 75 of Hoffman to support the rejection. As discussed above, the cited sections of the Office action do not disclose or suggest a fixed-length packet. Further, Paragraph 75 does not disclose or suggest encoding two types of status data into a single data field of a fixed-length data packet. Rather, Hoffman merely describes a signal indicating that a unit 40 was removed from a person. Paragraph 75 is silent with regard to a fixed-length data packet, silent as to encoding two types of status data into a single field, and silent as to encoding two types of status data into a single field of a fixed-length data packet.

Moreover, Hoffman does not disclose or suggest the shortcoming addressed by embodiments, namely, transmitting more status data over a fixed-length data packet. Further, Hoffman does not disclose the particulars of the protocol that is used, and does not disclose or suggest why it would be necessary to encode second and third types of status data in a second data field (rather than respective second and third data fields) of a fixed-length data packet, as recited in claims 1 and 51.

Accordingly, Hoffman does not disclose or suggest “encoding the second type of status data and the third type of status data in a second data field of a fixed-length data packet” as recited in claims 1 and 51.

D. Hoffman Does Not Disclose or Suggest Decoding A Downstream Message Code To Determine Requested Status Data As Recited In Independent Claims 20 and 70

Claims 20 and 70 are amended to recite that a downstream data packet comprising a downstream message code is “sent by a user to a remote device.” Applicants respectfully submit that Hoffman does not disclose or suggest “decoding the downstream message code to determine requested status data” as recited in claim 20 and “means for decoding the downstream message code to determine requested status data” as recited in claim 70.

Initially, as described by Hoffman, the “user” is the person 50 wearing the signaling unit 20 and wristband 40, and the “remote device” is the central dispatch station 80. (See, e.g., Hoffman, Para. 2). Hoffman explains that the unit 40 worn by the person 50 will “automatically generate a signal if the circuit is determined to be open (e.g., when the remote alarm switch unit 40 is unintentionally removed from the individual).” (Hoffman, Para. 74). Thus, the person 50 or user is not making any “request” and is not making a request for “status data.” Rather, a signal is generated automatically regardless of the user’s intention if the unit 40 is removed from the individual, e.g., when the person is being kidnapped. (Hoffman, Para. 53).

Correspondingly, Hoffman does not disclose or suggest “decoding the downstream message code to determine requested status data” as recited in claim 20 and “means for decoding the downstream message code to determine requested status data” as recited in claim 70, particularly in view of the context of the claims in which a downstream message code is sent by a user to a remote device, and the user requests status data.

E. Hoffman Does Not Disclose or Suggest An Upstream Data Packet Having A Plurality of Content Fields Including At Least One Content Field With A Plurality of Data Types

Claims 20 and 70 are amended to specify that an upstream data packet is transmitted “from the remote device to the user.” Applicants respectfully submit that Hoffman does not disclose or suggest “encoding the portion in an upstream data packet, the upstream data packet comprising a plurality of content fields including at least one content field which comprises a second plurality of data types” and “transmitting the upstream data packet from the remote device to the user” as recited in claim 20 and “means for encoding the portion in an upstream data packet, the upstream data packet comprising a plurality of content fields including at least one content field which comprises a second plurality of data types” and “means for transmitting the upstream data packet from the remote device to the user” as recited in claim 70.

As discussed above, Hoffman describes a “user” as the person 50 wearing the signaling unit 20 and wristband 40. (See, e.g., Hoffman, Para. 2). Further, as discussed above, Hoffman does not disclose or suggest encoding two types of status data into a single data field of a fixed-length data packet. Rather, Hoffman describes a signal indicating that a unit was removed from a person, but does not otherwise disclose that one content field of an upstream data packet transmitted by a remote device to a user includes a plurality of data types.

Accordingly, Hoffman does not disclose or suggest the “encoding” and “transmitting” limitations of claims 20 and 70.

F. Independent Claims 20 and 70 and Dependent Claims 21, 23, 24, 26, 29, 71, 73, 74, 76 and 79 Are Novel Over Hoffman

In view of the forgoing remarks, Applicants respectfully submit that independent claims 20 and 70 are novel over Hoffman. Accordingly, the rejection of independent claims 20 and 70 cannot meet the requirements of 35 U.S.C. § 102(e). Dependent claims 21, 23, 24, 26, 29, 71, 73, 74, 76 and 79 incorporate all of the elements and limitations of respective independent claims 20 and 70 and add novel and non-obvious limitations thereto. Accordingly, Applicants respectfully request that the rejection of these dependent claims under 35 U.S.C. § 102(e) be withdrawn.

Further, Hoffman fails to disclose or suggest limitations of other independent and other independent and dependent claims as discussed below.

**III. Independent Claims 12 and 62 Are Novel Over Hoffman**

Independent claims 12 and 62 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hoffman. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference MPEP § 2131 (emphasis added), citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306 (Fed. Cir. 2003). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicants respectfully submit that Hoffman cannot support the rejection in view of the above remarks. Hoffman is clearly deficient with regard to “fixed-length data packet” as recited in claims 12 and 62. Further, Hoffman does not disclose or suggest encoding location data and direction data as recited in claims 12 and 62.

Moreover, Applicants respectfully submit that Hoffman does not disclose or suggest “encoding the alarm code data and the speed data in a combined data field of the fixed-length data packet” as recited in claims 12 and 62. Applicants have searched Hoffman, and the reference does not refer to “speed.”

**IV. Dependent Claims Are Novel Over Hoffman**

Applicant respectfully submit that claims that depend from independent claims 1, 12, 20 51, 62 and 70 are also novel over Hoffman in view of the substantial deficiencies discussed

above. Applicants submit the following remarks concerning various dependent claims to further demonstrate that Hoffman cannot support the rejection.

A. Hoffman Does Not Disclose or Suggest Alarm Status Data Being One Of The Two Types Of Data in The Second Field Of The Fixed Length Packet As Recited in Dependent Claims 4, 24, 54 and 74

Applicants respectfully submit that Hoffman does not disclose or suggest “at least one of the second type of status data and the third type of status data comprises alarm status data” as recited in claim 4 and the related limitations of dependent claim 54. Applicants also respectfully submit that Hoffman does not disclose or suggest “wherein one or more content fields comprise an alarm data field,” the content field comprising a plurality of data types, as recited in claims 24 and 74.

As discussed above, the Office action has not set forth any basis regarding why the missing descriptive matter, i.e., each and every limitation of dependent claims 4, 24, 54 and 74, is necessarily present in Hoffman. Further, the Office action has not identified any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present in Hoffman.

Moreover, Hoffman does not provide any indication concerning why alarm data and another type of data would be encoded in the same field of a fixed-length data packet. Accordingly, the rejection of dependent claims 4 and 54 under 35 U.S.C. § 102(b) cannot stand.

B. Hoffman Does Not Disclose or Suggest An initial Step of Receiving A User's Request For At Least One of the First, Second and Third Types of Status Data As Recited in Dependent Claims 5 and 55

Applicants respectfully submit that Hoffman does not disclose or suggest “an initial step of receiving a user's request for at least one of the first, second and third types of status data” as recited in dependent claim 5 and “means for receiving a user's request for at least one of the first, second and third types of status data” as recited in dependent claim 55.

The Office action cites paragraph 55 to support the rejection. Paragraph 55, however, describes initiating a request that is sent from a central dispatch operator to an individual to determine the location of the individual, rather than a request sent from a user 5. The Office action assertion concerning paragraph 55 (signal from central dispatch operator to person) is inconsistent with paragraphs 73, 74, 77 (signal from person to central dispatch operator), which

were cited with regard to respective independent claims 1 and 51. Thus, the assertions are inconsistent with each other.

Accordingly, the rejection of dependent claims 5 and 55 under 35 U.S.C. § 102(b) cannot stand.

C. Hoffman Does Not Disclose or Suggest Receiving A User Item Control Command And Controlling A User Item According to the User Item Control Command

Applicants respectfully submit that Hoffman does not disclose or suggest receiving a user item control command and controlling a user item according to the user item control command as recited in respective dependent claims 6, 10, 18, 19, 26, 29, 56, 60, 68, 69, 76 and 79. Applicants note that independent claims 20 and 70 are amended to recite the a downstream data packet is sent by a user to a remote device, and the upstream packet is transmitted from the remote device to the user. Thus, dependent claims 26, 29, 76 and 79 must be read in view of these amendments.

The subject application explains that embodiments are directed to allowing a user, such as an owner of a motor vehicle, to control and update monitored events, alarm conditions, user notification devices, and contact information. (Para. 10). These control capabilities include allowing an owner to remotely control the vehicle by arming or disarming the vehicle alarm, locking or unlocking the vehicle doors, starting or stopping the vehicle engine, etc. (Para. 14).

The Office action refers to paragraphs 55 and 83 to support the rejection. Paragraph 55 describes an operator of the central dispatch initiating a request for location information for the person being monitored. Paragraph 83 describes circuits of circuitry of the portable signaling unit 20 and enabling of same. Thus, Hoffman is clearly deficient relative to these dependent claims since Hoffman does not disclose or suggest receiving a command to control a user item and does not disclose or suggest controlling a user item in response thereto.

V. **Claims 3, 7-9, 11, 13-16, 22, 25-28, 53, 57-59, 61, 63-65, 72, 75, 77 and 78 Are Patentable Over Hoffman**

Dependent claims 3, 7-9, 11, 13-16, 22, 25-28, 53, 57-59, 61, 63-65, 72, 75, 77 and 78 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hoffman. Under 35 U.S.C. § 103(a), to establish a *prima facie* case of obviousness of a claim, all the claim limitations must be taught or suggested by the prior art, and all words in a claim must be considered in judging the

patentability of that claim against the prior art. MPEP §§ 2143; 2143.03, citing *In re Royka*, 490 F.2d 981 (CCPA 1974). Moreover, there must be some suggestion or motivation to modify the reference, and a reasonable expectation of success. MPEP §§ 2143.01-2143.03, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In view of the above remarks, Applicants respectfully submit that Hoffman cannot support the rejection of these claims under 35 U.S.C. § 103(a) due to the deficiencies of the cited reference discussed above. MPEP § 2143.03 (all claim limitations must be taught or suggested).

Further, Applicants note that with regard to dependent claims 3, 13, 22, 53, 63 and 72, the Office action takes Official Notice that a fixed-length data packet having 15 digits is well known in the art, and that it would have been obvious to combine this teaching with Hoffman. However, “it is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based.” MPEP § 2144.03, citing *In re Surko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). “Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. *Id.*

In the instant case, the Office action relies solely on the general assertion that a 15 digit fixed-length data packet is well known in the art to reject claims 3, 13, 22, 53, 63 and 72. However, the Office action does not provide any further reasoning or evidentiary support to this assertion, and why there is a suggestion or motivation to make the asserted combination. Applicants submit that this is improper in view of the requirements set forth above.

Further, assuming *arguendo* that Hoffman is combined with a reference that is cited solely for the purpose of disclosing a 15 digit fixed-length packet, Applicants submit that such a combination would nevertheless fail to result in all of the elements and limitations of the claims in view of the deficiencies of Hoffman discussed above.

Accordingly, such a rejection is not proper. MPEP § 2143.03, citing *In re Royka*, 490 F.2d 981 (CCPA 1974). Moreover, the required suggestion on motivation to make this combination and/or modification is lacking in view of the description provided by Hoffman.

Applicants also respectfully submit that Hoffman is clearly deficient with regard to dependent claims that further specify aspects of the fixed-length data packet including the second data field occupying approximately one byte of upstream data, the location data comprising a 12-

digit data field, and the combined data field comprising a 2-digit data field. Hoffman fails to disclose or suggest any such limitations, and does not disclose or suggest the desirability of such limitations.

Thus, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

#### **VI. Conclusion**

In view of these amendments, Applicants respectfully request that application is in condition for allowance. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to contact the undersigned at the number indicated below.

If the rejection stands, Applicants respectfully request that the Examiner specify which section of Hoffman discloses each and every limitation of the claims rejected under § 102, and specify how Hoffman suggests the desirability of the asserted combinations/modifications concerning the rejections under § 103 in accordance with 37 C.F.R. § 104(c)(2) and MPEP §§ 2112 and 2131.01.

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Respectfully submitted,  
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